

**Remarks/Arguments:**

All claims of this application stand rejected under 35 U.S.C. section 103(a);  
In addition claim 8 is also rejected under 35 U.S.C. section 112.

I. Rejection of claims under 35 USC § 112 2d paragraph.

The Examiner is correct in noting that the word "onto" is missing in line 2 of claim 8. Claim 8 has been amended to introduce this word. Reconsideration and withdrawal of the rejection is respectfully requested.

II. Rejection of claims under 35 USC § 103(a).

(A) Claims 1-12' and 15-20 stand rejected under 35 U.S.C. § 103(a) as obvious in view of WO 98/30105, hereinafter Lonergan al., in view of United States patent No. 5,130,150 hereinafter Averbach. Claims 1 and 15 are independent claims. The rest depend either directly or indirectly therefrom.

Applicants have amended claims 1 and 15 by adding the limitation that the second fat application occurs while the baked dough is still warm. Support for this amendment is in page 10, lines 6-8 which read: "*The post baking fat application step should be carried out while the dough is still warm, usually within 3 minutes of removal from the oven and preferably within 1 minute.*"

(B) For the reasons given bellow, Applicants traverse the rejection and respectfully request reconsideration and allowance of the claims as amended.

As is well known in the doughnut making arts, "*Commercially, donuts fall into two broad categories: cake donuts, leavened by a baking powder chemical reaction which produces carbon dioxide, and yeast-raised donuts, leavened by yeast enzymes which react with sugar during fermentation to produce carbon dioxide and ethyl alcohol. Conventional cake donuts are prepared from a batter which is deposited into hot oil for frying. Yeast-raised donuts are produced from a dough*"

which is permitted to ferment before being fried in hot oil." (See Loh et al, U.S. patent number 5,804,243, field of the invention; emphasis added.)

This invention is directed to a process for creating a yeast raised doughnut without frying the doughnut thereby reducing the amount of fat in the finished product. Cooking of the doughnut is done through a sequence of unique steps that substitute baking for frying, yet still produce a lower fat product substantially indistinguishable from a traditionally prepared yeast raised doughnut. To the best of this applicant's knowledge no one has achieved this result prior to this invention.

As explained in the specification, yeast raised doughnuts are produced through a specific sequence of steps that impart to the finished product the characteristic "fluffiness inside a crisp skin" texture that is typical of a yeast raised doughnut. As stated on Loh above, the preparation of a yeast raised doughnut includes a proving step which is also described in the present specification, page 6, lines 24 to 27. *"The shaped dough portions are then subjected to a proving step at 40-43°C (105 to 110 °F) for 30 to 50 minutes with 55 to 60% relative humidity and left to cool for approximately 10 minutes. The proving step has the effect of increasing moisture content."*

Independent claims 1 and 15 are rejected as obvious in view of Lonergan et al. when considered together with the disclosure of Averbach. The rejection states that Lonergan et al. teaches that one may impart fried surface texture to a dough product, such as pizza crust, doughnut, beignet, tortilla etc. by applying an edible oil or combination of edible oils as a glaze to the dough prior to baking.

According to Lonergan et al, page 9, first full paragraph, *"Applicants have discovered that, simply by glazing a dough product prior to baking, the proper taste, texture, final baked product geometry and specific volume can be achieved, without a thawing or proofing step or, when traditionally required, a frying step."* (Emphasis added.) Thus, Lonergan et al. teaches a process that eliminates the use a proving step and therefore proven dough, Contrast to this, the pending claims language clearly refers to a process that is applied to "proven" dough, which means dough that has undergone such proving step.

Except for a passing reference to using his process to make, inter alia, doughnuts, (page 4 first paragraph and claim 30 which simply tracks the language of the above paragraph) all that Lonergan et al. teaches is a detailed process to make frozen pizza crust crusty following a later baking step, by coating the preproofed (or unproven) dough with a specified glaze. As Lonergan et al. state, subsequent baking of the frozen pizza at a temperature sufficiently high in effect fries the surface of the dough with the oil applied to it in the oven. Lonergan et al. offers no details whatsoever on how one would apply this process to a yeast raised doughnut. As a matter of fact Lonergan et al are silent regarding the kind of doughnut mentioned, specifically whether the process is applicable to a yeast raised doughnut, a cake doughnut or both. Considering the fact that Lonergan et al suggest using their process to avoid the proving step, the reasonable conclusion is that their process is directed to a process that does not include using proven dough as required by the present claim language.

In addition, the rejection admits that Lonergan et al. do not teach the second required step claimed in claim 1 to wit a second coating with a fat following baking.

To satisfy the missing elements, the rejection reaches to the disclosure in Averbach. Averbach teaches placing a moisture barrier on a doughnut, including a yeast-raised doughnut, following cooking, the moisture barrier comprising an edible oil in combination with an edible, tasteless wax, prior to coating the doughnut with a top coating such as icing etc. in order to increase shelf life of doughnuts. It is noteworthy that Averbach specifically rejects the use of an oil coating alone in column 2, lines 1-3 where it clearly states that "... (use of) oleaginous materials (fats and oils), it has been shown that, unless an undesirably thick coating is used, the barrier effect is ineffective."

In summary, Averbach teaches a process for creating a unique doughnut glaze composition to be used as a surface coating on the surface of a fully cooked doughnut. The Averbach process could be applied to a conventionally fried yeast raised doughnut or to a yeast raised doughnut prepared according to the present process. It is not a process step that is a substitute for the steps required to achieve the desired fried texture but an added step once the present process is completed.

The coating is applied to the doughnut to prevent moisture transfer to a subsequently placed glaze or other coating from the doughnut dough, thereby increasing product shelf life.

In his efforts to develop such protective barrier, Averbach teaches using a combination of edible oils and edible waxes in certain proportions to achieve a barrier layer that imparts no detectable change to the taste of the doughnut when compared with a similar doughnut that does not include such barrier. In column 9, for example, lines 14 – 17, Averbach states: *"Two panels of six people taste sections of doughnuts cut from coated and uncoated samples, and all six panelists agree that both sets of doughnuts taste the same."*

To the contrary, as explained in the specification the combination of claimed steps culminating to the second spray assure that the doughnut does not taste "baked" as one would expect following the baking step, but changes its texture and taste to taste the same as a yeast raised fried doughnut.

Averbach further does not teach any specific process for making the doughnuts, except to state in column 8 lines 63 to 68 that *"Doughnuts made from a yeast-raised are used since these are usually the base for 'honey dipped' doughnuts. The molten fat solution is maintained at 150° F. and the doughnut is immersed in the melt and withdrawn immediately. The coated doughnuts are allowed to cool for five minutes on a rack and then immersed into the glazing mixture and allowed to dry."* This statement does not teach a specific step of " ... applying a second coating comprising a second cooking fat to said baked proven dough mixture while said baked proven dough mixture is still warm from said baking step to form said yeast raised doughnut" as stated in the amended claims.

In summary, a complete review of Averbach shows that Averbach nowhere suggest that:

(1) the fat/wax composition applied by Averbach is "a second coating" because there is no suggestion that the fried yeast raised doughnuts have a first coating applied thereon to which this coating by Averbach is applied. Averbach simply uses

already fried doughnuts and coats them with a moisture barrier at some time after they have been fried; and

(2) that the coating must be applied while the dough emerging from the oven is still warm. Averbach's only restriction is that the coating solution be applied to a finished doughnut and that the coating solution, not the doughnut, be above a certain temperature.

Thus, all that Averbach stands for is that a moisture barrier comprising a very specific combination of ingredients, i.e. oil + wax in very specific concentrations may be placed on the surface of an already fried yeast-raised doughnut after the doughnut has been fried.

The Examiner's argument appears to be that because the art teaches that you can make baked dough (including an undisclosed type of doughnut dough) taste fried by spraying the dough prior to baking with an edible fat, and because other art shows that you can apply a particular type of glaze containing a hot oil and a wax mixture on the surface of a finished yeast raised doughnut to obtain a moisture barrier, the person skilled in the art would recognize that one may obtain a low fat content yeast raised doughnut having substantially the same texture and taste as a traditional yeast raised deep fried doughnut, by a process involving spraying the doughnut dough with a fat prior to baking followed by a second fat spray following baking while the dough is still warm.

In order to combine two references to demonstrate obviousness of an invention there must be some motivation found within the references themselves, not in the application under examination. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, *absent some teaching, suggestion or incentive* supporting the combination." *ACS Hospital Systems Inc. v. Montefiory Hospital*, 732 F2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)

Such teaching, suggestion or incentive is lacking in the present instance. Lonergan et al has taught us how to make crisp pizzas while Averbach is not even

remotely interested in making baked doughnuts taste like fried ones. He wants a moisture barrier to increase shelf life. The only teaching for a process comprising the two separate steps of pre and post fat application of an edible fat as claimed is in the present application, and cannot be used to combine two totally unrelated processes each of which alone achieves a different objective to defeat patentability of a new process used to obtain yet another result.

In view of Lonergan's teachings that his process eliminates the use of proven dough and Averbach's statements that applying an edible oil alone on a cooked doughnut the most one may say about combining the two references is that it may be obvious to try such combination of processes in an effort to obtain not a doughnut coated with a barrier layer, but a yeast raised doughnut that tastes like a fried one. As the courts have said, when at best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations .... this is not the standard of 35 U.S.C. 103. (In re Fine 5 USPQ2d 1596 (Fed. Cir. 1988); In re Geiger 2 USPQ2de 1276, 1278 (Fed. Cir. 1987).

For the aforementioned reasons, claims 1 and 15 are believed non obvious over the cited art and reconsideration and allowance are earnestly solicited.

(C) Claims 2-14 are dependent claims dependent of claim 1 and should also be allowed as such.

However claims 2, 3 and 4 are further limited to a process according to claim 1 wherein at least one of said first coating and said second coating consists essentially of a cooking fat or a combination of cooking fats (Claim 2) and wherein both fats consist essentially of... (claim 3).

The assertion that this language does not define over the prior art is respectfully traversed.

This language excludes any ingredients other than edible fats that when present materially modify the properties or function of the ingredient claimed under the term "consisting essentially of".

Therefore, the language "consists essentially of a cooking fat, or combination of cooking fats" used in claims 2, 3, and 4 excludes the coating compositions of Averbach which include a wax because the wax added is there for the specific purpose to change the result obtained by use of a fat alone. It also excludes Lonergan et al. because Lonergan et al. includes a viscosity modifying agent, to wit a hydrophilic colloid. Averbach himself admits that the addition of the wax materially changes the effect obtained through the use of a fat without the wax. Lonergan et al. states that a hydrophilic colloid is used in addition to the fat to obtain the desired result.

Therefore language limiting the claimed process to steps wherein at least one of the applied coating consists essentially of a fat, does indeed distinguish the applied prior art, because the art itself recognizes the criticality in the additional components of the compositions used in the art. Both references clearly state the criticality of the added ingredients which are excluded by the use of the language "consisting essentially of". What would be the effect of such ingredients if added in the current process is unknown, speculative, and therefore excluded by the selection of the claim language.

(D). Claims 15-20 also stand rejected for the reasons given regarding claims 2-4. The same arguments apply to these claims as well, and withdrawal of the rejection is respectfully requested.

(E). Claims 13, 14, 21 and 22 are rejected under 35 U.S.C. § 103 as obvious in view of Lonergan et al. taken over Averbach in combination with Loh et al.

Claims 13, 14, 21 and 22 include the limitation that the baking step includes applying steam to the proven dough. Neither Lonergan et al. nor Averbach hint at such process step. In order to fill in this omission, the rejecting argument uses Loh et al.

Loh et al. provides a clear statement of the two distinct types of doughnuts and clarifies the area of application of his invention and the reasons why. Loh et al. states in the field of the invention: *"This invention relates to the production of low-*

*fat (less than 10%) cake donuts. .... ".*

Loh et al. therefore teach a method applicable to a different product than the subject of this invention used to obtain a different result. Loh et al. maintain a cake-like texture for the doughnuts avoiding a crisp outside surface that tastes fried. To the contrary, the objective of the present invention is to avoid obtaining a cake doughnut texture and taste but to achieve the taste of a fried yeast raised doughnut through baking rather than frying. There is nothing in Loh et al. that would make one decide to inject steam when using the baking cycle of the present invention because in the present invention there is no desire to maintain a cake doughnut texture. If anything, Loh et al teach away from the claimed process.

Therefore claims 13, 14, 21 and 22 should be allowed on their own merit.

The remaining claims should also be allowed as being either directly or indirectly dependent from allowable claims.

(F) Claim 10 has been cancelled as being redundant following the amendment to claim 1.



**Conclusion.**

Neither Lonergan et al. nor Averbach alone disclose the claimed process. There is no motive within the applied references for combining the two processes to be found within the references. Tacking the Averbach process to the end of the Lonergan et al process still does not render all the claimed steps obvious because neither process includes the steps of applying to a proven dough a first coating of an edible fat, baking the coated proven dough, and applying a second coating of an edible fat while the proven baked dough is still warm to produce a yeast raised doughnut having the taste and texture of a fried yeast raised doughnut. In addition there is no suggestion that the fat applied should consist essentially of an edible fat, nor is there any hint that the baking step includes the application of steam. Finally Loh et al teach away from this invention by distinguishing the two types of doughnuts and by stating that use of steam during the baking step preserves the cake-like texture and taste of the cake doughnut, not a fried yeast raised doughnut.

For the above reasons, applicants respectfully request reconsideration of this application and early allowance of the claims as amended.

Respectfully submitted,



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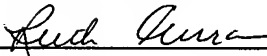
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